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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,227	04/16/2004	Andrew E. Fano	33836.00.0046	9661
7590 Vedder Price PC 222 N. LaSalle Street Chicago, IL 60601				
			EXAMINER PENG, FRED H	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 08/20/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,227

Applicant(s)

FANO ET AL.

Examiner

FRED PENG

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21, 25-35, 38, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-19, 21, 25-35, 38, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 05/01/2008 have been fully considered but they are not persuasive.

Applicant argues on page 12 line 22 – page 13 line 3 of Remarks that Lopez-Estrada fails to teach the use of criteria that are defined according to the content of the multi-media program content, i.e. that are content –specific and therefore fails to anticipate each and every limitation of Claims 1 and 38.

The Examiner respectfully disagrees with applicant's arguments. Lopez-Estrada teaches playing back the segments based on chapter labels of the video stream which is used to identify the user's favorite parts in a movie (Para 22 lines 1-8; Para 27 lines 6-10). The chapter label is used to identify the specific segment of a program (Para 20 lines 9-12) and hence the chapter label is defined as a content specific of the multi-media program.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7, 9-15, 25-26, 28-31, 34-35 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Lopez-Estrada et al (US 2003/0035648).

Regarding Claims 1, 4 and 38, Lopez-Estrada discloses an apparatus with corresponding method for play back of multi-media program material comprising:

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a multi-media playback unit, capable of selectively playing back segments of a multi-media program material (FIG.2C; element 30);

a memory wherein program instructions are stored to perform the function (Para 28);

a first controller, operatively coupled to said multi-media playback unit and to the memory (Para 28), said controller operable to cause the apparatus, when executing the program instructions to perform the functions of:

playing back from the multi-media program material, a first segment of the multi-media program material selected according to a first criteria that is defined according to content of the multi-media program material (Para 22 lines 1-8; Para 27 lines 6-10; playback a first segment based on a requested user's favorite chapter labels; a chapter label is defined according to content of the multi-media program material); and

suppressing playback of a second segment of the multi-media program material, based on the content of the at least one second segment selected according to a first criteria that is defined according to content of the multi-media program material (Para 22 lines 8-14; Para 23 lines 22-30; skip a second segment if the segment is not the requested user's favorite chapter labels like commercial);

playing back from the multi-media program material, a third segment of the multi-media program material selected according to the first criteria (Para 22 lines 8-18; Para 27 lines 6-10; play a third segment if the segment is the requested user's favorite chapter labels).

Regarding Claims 2 and 3, Lopez-Estrada further discloses said first criteria and said second criteria are comprised of indexes within said multi-media program material that identifies a beginning of a segment (Para 22 lines 1-5; chapter label is an index identifying the beginning of a segment).

Regarding Claim 5, Lopez-Estrada further discloses said second segment is ordered after said first segment and said third segment is ordered after said second segment in said multi-

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media program material (Para 23 lines 22-30; scene 1 is first segment, commercial in between is second segment and scene 2 is third segment).

Regarding Claim 6, Lopez-Estrada further discloses the third segment is ahead of the first segment (Para 27; DVD inherently play preview, the second segment, before feature program; the segment after the second segment is the third segment).

Regarding Claim 7, Lopez-Estrada further discloses said first segment selected for playback includes a segment of video of a first portion of said multi-media program material and a segment of audio of a second portion of said multi-media program material (Para 16 lines 8-10).

Regarding Claim 9, Lopez-Estrada further discloses first criteria including a user's preferences to playback predetermined content (Para 27 lines 8-12).

Regarding Claim 10, Lopez-Estrada further discloses said first criteria includes a user's specified playback time of said multi-media program material (Para 20 lines 1-4).

Regarding Claim 11, Lopez-Estrada further discloses viewing said multi-media program material;

identifying content segments in said multi-media program material that conform to at least one criteria (Para 20);

indexing said content segments by adding an index in said multi-media program (Para 20; segments identified as chapters).

Regarding Claim 12, Lopez-Estrada further discloses viewing said multi-media program material; and annotating said multi-media program material (Para 20).

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Regarding Claim 13, Lopez-Estrada further discloses a user-specified time period, during which said multi-media program material is to be reviewed (Para 20 lines 1-4).

Regarding Claim 14, Lopez-Estrada further discloses the content for display is selected based on data embedded in said multi-media program material (Para 27).

Regarding Claim 15, Lopez-Estrada further discloses the content for display is selected based on data transmitted with said multi-media program material (FIG.2B).

Regarding Claims 25 and 26, Lopez-Estrada further discloses adding an annotation that that substantially contemporaneously describes information in said multi-media program material and is imbedded in the multi-media program (FIG.2B, element 22; Para 21 lines 10-17).

Regarding Claims 28 and 29, Lopez-Estrada further discloses storing and transmitting said multi-media program material and said index on a storage media from which said program material can be played back and from which said annotation can be detected (FIG.2B; element 26; Para 26).

Regarding Claims 30 and 31, Lopez-Estrada further discloses detecting a viewer's input control signal to a multi-media playback device (FIG.2B, elements 23 and 24; Para 19);

adding a content segment to a first multi-media program in response to the user's input control signal and the added content segment is third party advertising content (Para 23 lines 22-30; add a commercial between 18 and 23 minutes into the program).

Regarding Claim 34, Lopez-Estrada further discloses suspending the display of said multi-media program on a display device; and displaying said content segment on said display

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device while the display of said multi-media program is suspended (Para 22 lines 22-30; the program is suspended when the commercial is played).

Regarding Claim 35, Lopez-Estrada further discloses transitioning play back of first and second segments of said multi-media program; and playing back said content segment between said first and second segments of said multi-media program (Para 23 lines 22-30).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 18-19, 21 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez-Estrada et al (US 2003/0035648).

Regarding Claim 8, Lopez-Estrada discloses multi-media program material (Para 12) but not specifically about multi-media program material is comprised of at least one of a televised sporting event.

The Official Notice is taken that it is well known in the art that multi-media program material is comprised of at least one of a televised sporting event.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a televised sporting event as one of the most popular event for television.

Regarding Claims 18, 19 and 33, Applicant admits it is well known in the art to blend an overlay segment with a multi-media program (Specification Para 91).

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Official Notice is also taken that it is well known in the art that the overlay segment is either semi-transparent or opaque.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include playing a multi-media program on a predetermined area of a display device with added content segment being presented substantially simultaneously with the display of said multi-media program.

Regarding Claim 21, Lopez-Estrada is silent about overlay content is determined by a user preference.

The Official Notice is taken that it is well known in the art to send a reminder or a message to a user to watch or record a program.

6. Claims 16-17 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez-Estrada et al (US 2003/0035648) in view of Linnartz (US 6,947,573).

Regarding Claims 16-17 and 27, Lopez-Estrada is silent about identifying the owner of copyright and determining if requiring compensation.

In an analogous art, Linnartz discloses adding a watermark into a digital media stream to identify the owner of the copyright and trace illegal copies (Col 1 lines 16-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a watermark as taught by Linnartz with the added benefits of right protection and revenue increase.

7. Claims 32, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez-Estrada et al (US 2003/0035648) in view of Goldstein (US 5,410,326).

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Regarding Claims 32, 40 and 41, Lopez-Estrada is silent about a wireless controller capable of receiving information from said first controller and displaying content segment that contain third party advertising segments.

In an analogous art, Goldstein discloses a wireless controller capable of receiving information from said first controller and displaying content segment that contain third party advertising segments (FIG.6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lopez-Estrada's system to include a wireless controller capable of receiving information from said first controller and displaying content segment that contain third party advertising segments as taught by Goldstein with added convenience to use commonly used remote control.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRED PENG whose telephone number is (571)270-1147. The examiner can normally be reached on Monday-Friday 09:00-18:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Annan Q Shang/
Primary Examiner, Art Unit 2623

Fred Peng
Patent Examiner

Vivek Srivastava
Supervisory Patent Examiner